REMARKS

Applicants respectfully request reconsideration and reexamination of the present application in light of the amendments and the remarks below.

Claims 1 and 2 are pending in this application. Claim 1 has been amended. This claim amendment is made to clarify the subject matter therein. Therefore, these amendments are submitted in order to place the claims in condition for allowance, and do not disclaim any subject matter to which the Applicants are entitled.

Rejection Under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for treating Parkinson's disease, does not reasonably provide enablement for preventing Parkinson's disease (Paper No. 6, page 2). Applicants respectfully traverse.

Claim 1 has been amended. Specifically, the claim no longer recites preventing Parkinson's disease.

It is thus submitted that the claims meet the requirements of 35 USC § 112, first paragraph, and reconsideration and withdrawal of the present rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1 and 2 under under 35 U.S.C. § 103(a) as unpatentable over Schohe-Loop, et al. (U.S. Patent No. 5,942,529; Reference U2) in view of Fahrig, et al. (U.S. Patent No. 6,235,774; Reference U1), and in further view of Merck Manual (pages 344-346) (Paper No. 6, page 3-4). Applicants respectfully traverse.

To properly maintain a rejection under 35 U.S.C. § 103, three conditions must be met. First, the prior art must have suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process. Second, the prior art must also have revealed that in so making or carrying out, those of ordinary skill in the art would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in the Applicant's disclosure. Finally, the prior art reference must teach or suggest all the claim limitations. *See In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The present invention relates to a method of treating Parkinson's disease comprising administration of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide.

As stated by the Examiner, Schohe-Loop, et al., does not suggest the use of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide to treat Parkinson's disease (Paper No. 6, page 3). Fahrig, et al., discloses a generic formula, but does not specifically suggest the use of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-

benzisothiazol-3(2H)-one 1,1-dioxide to treat Parkinson's disease. The Merck Manual provides a description of Parkinson's disease, but does not suggest using 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide to treat Parkinson's disease. Thus, based on the disclosures of Schohe-Loop, et al., Fahrig, et al., and the Merck Manual, one skilled in the art would not have been motivated to select that specific compound to treat Parkinson's disease. Furthermore, based on the disclosures of the prior art references, one skilled in the art would not have been motivated to administer 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide to alleviate the severity of symptoms of Parkinson's disease. That is, it has been demonstrated that 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide possesses symptomatic activity, (i.e., it decreases the degree of severity of symptoms) (*see, e.g.*, page 6-7 of the specification). Neither Schohe-Loop, et al., Fahrig, et al., nor the Merck Manual suggest administering 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}-amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide to alleviate the severity of symptoms of Parkinson's disease.

It is therefore respectfully submitted that Schohe-Loop, et al., either singly or in combination with Fahrig, et al., and/or Merck Manual fails to teach or suggest the methods as presently claimed, and that the current invention is novel and nonobvious in view of the prior art references. For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the present rejection.

CONCLUSION

For the foregoing reasons, Applicants submit that the claims are in condition for allowance and Applicants respectfully request reexamination of the present application, reconsideration and withdrawal of the present rejections, and entry of the amendments. Should there be any further matter requiring consideration, Examiner Wang is invited to contact the undersigned counsel.

If there are any further fees due in connection with the filing of the present reply, please charge the fees to undersigned's Deposit Account No. 13-3372. If a fee is required for an extension of time not accounted for, such an extension is requested and the fee should also be charged to undersigned's deposit account.

Respectfully submitted,

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Claims (Attorney Docket No. LeA 34 992)

1. (Currently amended) A method of ~~preventing or~~ treating Parkinson's disease comprising administering an effective amount of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)-butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide, its physiologically acceptable salts, hydrates or solvates.

2. (Previously amended) The method of claim 1 comprising administering an effective amount of 2-[4-({[(2R)-8-isopropoxy-chroman-2-yl]methyl}amino)butyl]-1,2-benzisothiazol-3(2H)-one 1,1-dioxide hydrochloride.

3. Cancelled.

4. Cancelled.